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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,569	07/29/2003	Yannis Labrou	1634.1004	4126
21171	7590	10/19/2007		
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER HEWITT II, CALVIN L	
			ART UNIT 3621	PAPER NUMBER
			MAIL DATE 10/19/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/628,569

Applicant(s)

LABROU ET AL.

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 August 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8-30-07</u> . | 6) <input type="checkbox"/> Other: _____  |

### ***Status of Claims***

1. Claims 1-36 have been examined.

### ***Claim Objections***

2. Claims 12 and 13 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 12 recites "a consumer mobile device without a *display...*", while claim 6, from which claim 12 depends, recites "a display". Claim 13 is also objected to it recites language similar to 12.

### ***Response to Amendments/Arguments***

3. Applicant's claims continue to rely on functional language in order to distinguish the claimed apparatus from the prior art. For example, claim 1 now recites "*executing ... a symmetric agreement verification protocol as a Secure Transaction Protocol verifying* a purchase transaction between the merchant and

the consumer based upon both a *first input parameter and a second stored parameter* of the consumer mobile device *identifying the consumer to the STS device*.” Recall, it has been held that while features of an apparatus may be recited either structurally or functionally, *claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone* (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)). In addition, “a recitation with respect to the material intended to be worked upon by a claimed apparatus *does not impose any structural limitations upon the claimed apparatus* which differentiates it from a prior art apparatus satisfying the structural limitations of that claimed” (*Ex parte Masham*, 2 USPQ2d 1647 (1987)) and language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP 2106 II, C). Therefore, as the combined art of Ferguson et al. and Nordenstam et al. teach Applicant’s apparatus (i.e. system), neither software executing on components of the Apparatus (e.g. web browser-claim 4), how its components are used (e.g. accepts a private identification number- claim 3, as a proximity binding- claim 9, access point operated by the merchant and granting access to the consumer mobile device- claim 33, protecting the integrity- claim 35), nor optional language (e.g. can be- claim 7) will further distinguish Applicant’s claims in terms of patentability.

As per claim 36, Nordenstam et al. also teach a device on a network performing traffic management functions (page 14, lines 1-3) according to geographic constraints (page 14, lines 12-13).

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 5, 12, 13, and 29-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation "the Secure Transaction Protocol" in line 7. There is insufficient antecedent basis for this limitation in the claim.

Claim 12 recites "a consumer mobile device without a *display*...", while claim 6, from which claim 12 depends, recites "a display". To one of ordinary skill the structure of the mobile device is unclear. Claim 13 is also rejected as it recites similar language.

Claim 29 recites the limitation "the merchant retail application program" in lines 1-3. There is insufficient antecedent basis for this limitation in the claim (consider the following claim branch- 29->28->27->1).

Claims 30-32 are also rejected as each depends from claim 29.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson et al., U.S. Patent No. 5,256,863 in view of Nordenstam et al., WO 00/46959.

As per claims 1-36, Ferguson et al. teach a computer system comprising:

- a merchant operated device (abstract; figures 1 (items 6 and 8), 3 and 4; column/line 8/3-9/34)
- a transaction server device (abstract; figures 1 (item 10) and 8; column/line 14/62-17/5; column 18, lines 57-64; column 20, lines 9-58)

- one or more payment service devices (abstract; figure 1, item 22; column/line 15/60-16/2; column 18, lines 57-64; column 20, lines 20-28)
- a wired or wireless communication network between the merchant device and the server, and the server and the payment service devices (figure 1)

Ferguson et al. teach a user with a payment card making a purchase at the merchant operated device (abstract; figures 1 and 4; column/line 4/55-5/25; column 9, lines 5-11; column/line 15/60-16/2; column 18, lines 57-64; column 20, lines 20-28). However, Ferguson et al. do not specifically recite wireless networks for interfacing a user's card with the merchant device.

Nordenstam et al. teach a computer system comprising:

- a Bluetooth or any other wireless network (open and non-secure) (figures 1-3; page/line 11/18-15/10)
- a mobile device (e.g. PDA, phone) comprising a wireless interface, user input feature, web browser, a processor and biometric sensor (figures 1 and 3 (items 10A and B); page 9, lines 12-20; page 10, lines 5-29; page 11, lines 18-27; page 16, lines 24-30; page/line 25/30-26/12; page/line 26/22-27/5)
- a merchant device comprising a wireless interface (figure 3)

More specifically, Nordenstam et al. teach a user with a mobile device comprising a payment card (page 8, lines 10-30; page/line 9/12-11/17; page 24, lines 10-29) wherein the device/card is used to make purchases by wirelessly communicating payment card data to the merchant device (page 15, lines 26-32; page 16, lines 14-22; page 21, lines 5-25). Nordenstam et al. also teach a device on a network performing traffic management functions (page 14, lines 1-3) according to geographic constraints (page 14, lines 12-13). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Ferguson et al. and Nordenstam et al. in order to reduce the amount of cards handled by a user and increase security ('959, page 2, lines 5-12).

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory



period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

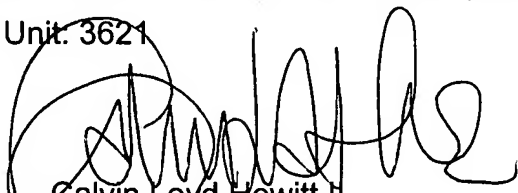
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Calvin Loyd Hewitt II  
Primary Examiner

October 16, 2007